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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/810,458	03/16/2001	Raymond Vincent Heaven Jones	PPD-50351A/C1	7707

26748 7590 06/23/2004

SYNGENTA CROP PROTECTION, INC.  
PATENT AND TRADEMARK DEPARTMENT  
410 SWING ROAD  
GREENSBORO, NC 27409

EXAMINER

ZUCKER, PAUL A

ART UNIT PAPER NUMBER

1621

DATE MAILED: 06/23/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/810,458

**Applicant(s)**

JONES ET AL.

**Examiner**

Paul A. Zucker

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Current Status*

1. This action is responsive to Applicants' amendment<sup>1</sup> of 28 January 2002, 5 March 2002 and 8/6/2003 in Papers No 6,9 and 11, respectively.
2. Receipt and entry of Applicants' amendments is acknowledged.
3. Applicant's cancellation of claim 5 is acknowledged.
4. Claims 1-4 and 6-15 are pending.
5. The objection to the claims set forth in paragraph 1 of the Office Action in Paper No 4 is withdrawn in response to Applicants' amendment.
6. Claims 1-4 and 6-15 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Hirai et al (US 5,886,211 03-1999). Hirai discloses (Example 15, Column 14, line 48- column 15, line 9) a process for the production of 3-isochromanone by the palladium catalyzed carbonylation of  $\alpha,\alpha'$ -o-xylene dichloride with carbon monoxide with a tertiary butyl alcohol- water mixture as solvent in the presence of a pre-formed triphenylphosphine-palladium catalyst in the presence of a base. Hirai specifically suggests a variety of catalysts (Column 6, line 13-Column 7, line 4) which are used in the amount of 0.0001-0.5 mole per mole reactant (Column 7, lines 5-8). Hirai also specifically suggests a range of ligands including a variety of phosphines (Column 7, lines 14-30) used in the amount 0.5 to 10 equivalents (Column 7, lines 31-34). A wide variety of bases are suggested, used in the amount of 1 to 10 molar equivalents relative to the dihalide (Column 7, lines 52-55), including the amine bases pyridine, triethylamine and trimethylamine although the inorganic bases are

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preferred by Hirai. A wide variety of tertiary alcohols are contemplated (Column 8, lines 16-36) as well as the use of phase transfer catalysts in the two-phase system (Column 8, line 37-Column 9, line 38). Thus Hirai anticipates instant claims 1-4 and 6-15.

***Examiner's Response to Applicants' Remarks with Regard to this Rejection***

7. Applicants present several arguments with regard to this rejection. The Examiner responds to these below:

- a. Applicants argue that Hirai's process differs from Applicants' in two main respects:
  - i. Hirai's process uses a different base. Applicants point out that the example employ either calcium or sodium hydroxide as base. The Examiner agrees that this is true. The Examiner, however, disagrees with Applicants' conclusion that this renders Applicants' process patentable over Hirai since Hirai teaches the equivalence of amine and inorganic bases.
  - ii. Hirai points one of skill in the art in the direction of less water than solvent. The Examiner disagrees that Hirai points one of skill in the art in the direction of less water than solvent. Hirai, in fact, teaches a broad range of solvent ratios that include those claimed by Applicants. This is supported by Example 6 of Applicants' tabular presentation of the Examples of Hirai

b. Applicants further argue that Hirai's process does not lend itself to scaling up and that Hirai's process:

- i. Does not permit recycling of base;
- ii. Adds water gradually;
- iii. Is not suitable for catalyst recycle.

In response to Applicant's argument that the references fail to show certain features of Applicant's invention, it is noted that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

c. In summary, Applicants argue that even if a skilled person were minded to replace Hirai's inorganic base with a tertiary amine, Applicants' claimed process would not be produced. The Examiner disagrees. If one of ordinary skill in the art were to replace the sodium hydroxide base of Hirai's Example 6 with the equivalent (as taught by Hirai) triethylamine, Applicant's claimed process is produced precisely.

Applicant's arguments filed 28 January 2002 have been fully considered but they are not persuasive for the reasons set forth above.

8. Upon further consideration by the Examiner, the rejection under 35 U.S.C. §103 (a) over Hirai et al (US 5,886,211 03-1999) and Jones et al (WO 99/103365 03-1999)

withdrawn. This rejection does not treat any features of the present claims not addressed by the rejection under 102 above. The Examiner notes that Applicants have not perfected their claim under 35 U.S.C. §120 to the international application.

A reference to the international application in the first line of the specification is required. Applicants are therefore not entitled to benefit of the filing date of the earlier filed application.

***Conclusion***

9. Claims 1-4 and 6-15 are pending. Claims 1-4 and 6-15 are finally rejected.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

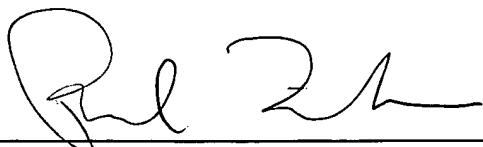
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. Zucker whose telephone number is 571-272-0650. The examiner can normally be reached on Monday-Friday 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Paul Zucker', written over a horizontal line.

Paul A. Zucker, Ph. D.  
Patent Examiner  
Technology Center 1600